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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/708,235	11/07/2000	Kevin Calloway	GOL5121.11A	1158

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EXAMINER

ALVAREZ, RAQUEL

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 09/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/708,235

Applicant(s)

CALLOWAY ET AL.

Examiner

Raquel Alvarez

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 6/21/04.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-63 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-63 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 4/9/2002.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-63 are presented for examination.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claim 55 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

As an initial matter, the United States Constitution under Art. I, §8, cl. 8 gave Congress the power to "[p]romote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries". In carrying out this power, Congress authorized under 35 U.S.C. §101 a grant of a patent to "[w]hoever invents or discovers any new and useful process, machine, manufacture, or composition or matter, or any new and useful improvement thereof." Therefore, a fundamental premise is that a patent is a statutorily created vehicle for Congress to confer an exclusive right to the inventors for "inventions" that promote the progress of "science and the useful arts". The phrase "technological arts" has been created and used by the courts to offer another view of the term "useful arts". See *In re Musgrave*, 167 USPQ (BNA) 280 (CCPA 1970). Hence, the first test of whether an invention is eligible for a patent is to determine if the invention is within the "technological arts".

Further, despite the express language of §101, several judicially created exceptions have been established to exclude certain subject matter as being patentable subject matter covered by §101. These exceptions include "laws of nature", "natural phenomena", and "abstract ideas". See *Diamond v. Diehr*, 450, U.S. 175, 185, 209 USPQ (BNA) 1, 7 (1981). However, courts have found that even if an invention incorporates abstract ideas, such as mathematical algorithms, the invention may nevertheless be statutory subject matter if the invention as a whole produces a "useful, concrete and tangible result." See *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* 149 F.3d 1368, 1973, 47 USPQ2d (BNA) 1596 (Fed. Cir. 1998).

This "two prong" test was evident when the Court of Customs and Patent Appeals (CCPA) decided an appeal from the Board of Patent Appeals and Interferences (BPAI). See *In re Toma*, 197 USPQ (BNA) 852 (CCPA 1978). In *Toma*, the court held that the recited mathematical algorithm did not render the claim as a whole non-statutory using the Freeman-Walter-Abele test as applied to *Gottschalk v. Benson*, 409 U.S. 63, 175 USPQ (BNA) 673 (1972). Additionally, the court decided separately on the issue of the "technological arts". The court developed a "technological arts" analysis:

The "technological" or "useful" arts inquiry must focus on whether the claimed subject matter...is statutory, not on whether the product of the claimed subject matter...is statutory, not on whether the prior art which the claimed subject matter purports to replace...is statutory, and not on whether the claimed subject matter is presently perceived to be an improvement over the prior art, e.g., whether it "enhances" the operation of a machine. *In re Toma* at 857.

In *Toma*, the claimed invention was a computer program for translating a source human language (e.g., Russian) into a target human language (e.g., English). The

court found that the claimed computer implemented process was within the "technological art" because the claimed invention was an operation being performed by a computer within a computer.

The decision in *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* never addressed this prong of the test. In *State Street Bank & Trust Co.*, the court found that the "mathematical exception" using the Freeman-Walter-Abele test has little, if any, application to determining the presence of statutory subject matter but rather, statutory subject matter should be based on whether the operation produces a "useful, concrete and tangible result". See *State Street Bank & Trust Co.* at 1374. Furthermore, the court found that there was no "business method exception" since the court decisions that purported to create such exceptions were based on novelty or lack of enablement issues and not on statutory grounds. Therefore, the court held that "[w]hether the patent's claims are too broad to be patentable is not to be judged under §101, but rather under §§102, 103 and 112." See *State Street Bank & Trust Co.* at 1377. Both of these analysis goes towards whether the claimed invention is non-statutory because of the presence of an abstract idea. Indeed, *State Street* abolished the Freeman-Walter-Abele test used in *Toma*. However, *State Street* never addressed the second part of the analysis, i.e., the "technological arts" test established in *Toma* because the invention in *State Street* (i.e., a computerized system for determining the year-end income, expense, and capital gain or loss for the portfolio) was already determined to be within the technological arts under the *Toma* test. This dichotomy has been recently acknowledged by the Board of Patent Appeals and Interferences (BPAI) in affirming a

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§101 rejection finding the claimed invention to be non-statutory. See *Ex parte Bowman*, 61 USPQ2d (BNA) 1669 (BdPatApp&Int 2001).

In the present application, independent claim 55 clearly recites "useful, concrete and tangible result" ("personalizing a multimedia message for a recipient based on the retrieved information"), however the claim recites no structural limitations (i.e., computer implementation), and so it fails the first prong of the test (technological arts).

Claim Rejections - 35 USC § 102

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

3. Claims 1-7, 9-11, 20-21, 24-30, 32, 49, 55, 57-58 are rejected under 35 U.S.C. 102(a) as being anticipated by Hibbeler (6,067,348 hereinafter Hibbeler).

With respect to claims 1-7, 9-11, 55, 57, 58 Hibbeler teaches a system for creating and distributing a series of individualized multimedia messages over a computer network for a plurality of recipients (Abstract). A recipient information repository (Figure 11, 300); a multimedia content repository (Figure 2); means for creating and delivering individualized multimedia content over said network to each of the plurality of recipients, wherein said multimedia content is assembled from selected elements with the multimedia content repository which are selected in response to information about each of said recipients whose information is extracted from the recipient information repository (col. 3, lines 51-67).

With respect to claims 20, 21, 24-30, 32, 49-50 Hibbeler teaches a system for creating and distributing individualized multimedia messages over a computer network (Abstract). A computer operatively connected to said network and executing a programmed sequence of instructions (See Figure 11, 1110); a recipient information access routine with said programmed sequence of instructions which is capable of accessing data about a given intended recipient (Figure 11, 300); a content repository containing multimedia elements that may be combined to form individualized messages (Figure 2); a content management routine within said programmed sequence of instructions which is capable of retrieving selected multimedia content from the content repository, wherein the process of selecting multimedia content is responsive to information content regarding the given recipient accessed by the recipient information access routine (see Figure 11, 1110); a multimedia engine routine within said programmed sequence of instructions which packages the multimedia content as individualized message for delivery to the given recipient (Figure 11); a delivery routine within said programmed sequence of instructions which delivers the individualized message to the given recipient (Figure 11, 1120).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 8, 12-19, 22-23, 33-48, 51-54, 56, 59-63 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hibbeler.

Claim 8 further recites a clean up routine which cleans up a recipient database by removing errors and unwanted redundancies. Official notice is taken that is old and well known in the computer related arts to remove errors and unwanted redundancies from a database in order to free memory space and to leave just useful information in the database. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included a clean up routine which cleans up a recipient database by removing errors and unwanted redundancies in order to obtain the above mentioned advantage.

Claims 12-18, 33-38, 54, 56, 59-63 further recite delivering the message via various e-mail formats. Hibbeler teaches transmitting the message over the Internet (col. 6, lines 38-40) therefore delivering messages via e-mail including various formats would have been obvious convenient and widely use by computer users.

Claims 19 and 23 further recite printing the individualized messages. Official notice is taken that is old and well known to print individualized messages to the customer in order to provide a more permanent output. It would have been obvious to a

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person of ordinary skill in the art at the time of Applicant's invention to have included printing the individualized messages in order to obtain the above mentioned advantage.

Claims 22 and 31 further recites known computer programming languages. Since Hibbeler teaches transmitting the message over the Internet (col. 6, lines 38-40) then it would have been obvious to have included the various programming languages.

Claims 39-40, 42-43, 45 further recite allowing direct client input and a search engine. Official notice is taken that is old and well known in computer related arts to allow direct client input in order to take the user's objectives, likes and dislikes into account for later customization of the data and a search engine for finding information . It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included allowing direct client input and a search engine in order to obtain the above mentioned advantage.

Claims 41, 44 and 46 further recite restricting non-authorized parties from accessing a client campaign and files check in and out. Official notice is taken that is old and well known in the computer related arts to restrict non-authorized parties from accessing certain information and files check in and out. For example, certain employees would not have access to certain classified information for security reasons and keeping track of the files checked in and out to keep track of whoever is using those files. It would have been obvious to a person of ordinary skill in the art at the time of

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Applicant's invention to have included restricting non-authorized parties from accessing a client campaign and to manage file check in and out in order to achieve the above mentioned advantage.

Claim 47 further recites real time report and usage statistics. Official notice is taken that is old and well known in the computer related arts to real time reporting and usage statistics because such a modification would allow for collection, analysis and interpretation of the data collected.

Claim 51 further recites modifying the individualized message with an offer, rebate or discount. Official notice is taken that is old and well known in the computer related arts to offer an individualized, message or discount to a customer in order to increase the like hood that the customer will use the offer. For example, a couple with children will be given a children related offer that will take into account the customer needs. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included modifying the individualized message with an offer, rebate or discount in order to obtain the above mentioned advantage.

Claim 52 further recites a word-of mouth form of advertisement. Official notice is taken that is old and well known in marketing to promote word-of mouth form of

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advertisement because such a modification would provide an inexpensive reliable form of advertisement.

Claim 53 further recites collecting user's recommendations. Official notice is taken that is old and well known to collect user's recommendations and input in order to use the information to improve and make modifications to the system in place. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included collecting user's recommendations in order to achieve the above mentioned advantage.

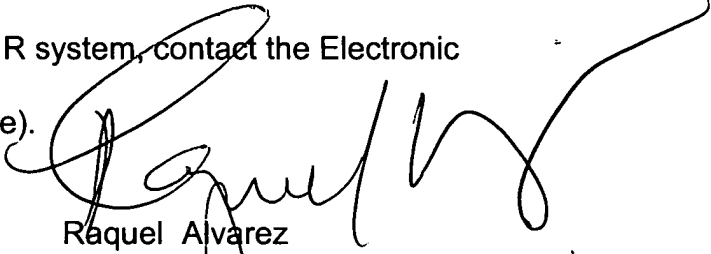
Point of contact

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raquel Alvarez whose telephone number is (703)305-0456. The examiner can normally be reached on 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric w Stamber can be reached on (703)305-8469. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Raquel Alvarez
Primary Examiner
Art Unit 3622

R.A.
9/3/04